

REMARKS

Claims 1-20, 22, 24-33, 35-50, 52-54 and 56 are pending. Reconsideration and further examination is respectfully requested.

The Examiner rejected claims 1-20, 22, 24-33, 35-50, 52-54 and 56 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2001/0011241 A1 to Nemzow ("Nemzow"). This rejection is respectfully traversed.

Nemzow discloses a currency translation system that seeks value optimization where there "is not a straightforward application of conversion rules to input data." (Nemzow, para. 53.) As made clear in paragraphs 53 through 60, Nemzow uses "optimization techniques...to maximize objective currency valuation and/or minimize conversion and transaction costs" when there is missing or out-of-date data. Thus, Nemzow does not seek an accurate valuation where the transaction does not correspond to a historical exchange rate; it seeks to optimize the value of the transaction when there is missing data.

The Examiner states that "Nemzow does disclose that a user can specify conversion rules" and that "the broad language of Nemzow would allow for any user specified conversion and transaction rules." (2/27/06 Office Action at 4 (emphasis added).)

Applicants respectfully disagree. Nemzow does not adequately describe "any user specified conversion and transaction rules" to be used when there are missing conversion values for a particular transaction date. (Id. (emphasis added).) Rather, even where Nemzow relies on "user input" to customize its conversion rules, Nemzow teaches the use of "a number of optimization methods" to "optimize the value of the currency using the user specification," as described in paragraph 53. Nemzow discloses the use of user input to "yield the most value" and "preserve most of the value in the base currency in the conversion process." (Nemzow, para. 53.)

Nemzow thus teaches away from what the Examiner asserts Nemzow teaches.

Nemzow teaches optimizing the value of the base currency in the conversion process. The selection of a historical exchange rate in the manner that the Examiner claims Nemzow teaches is different from the value optimization contemplated by Nemzow. Fundamentally, selecting a historical exchange rate is an attempt to obtain an accurate valuation, while optimization is an attempt to maximize a valuation. Thus, the two techniques are entirely distinct and are not even directed toward solving the same overall problem. Since Nemzow does not teach what the Examiner asserts, the rejection is unsupported by the art and should be withdrawn.

The reference fails to establish a *prima facie* case. MPEP § 2142 states "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)" (emphasis added.)

Indeed, the Examiner relies on hindsight in reaching the obviousness determination. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983.) In the absence of some teaching or suggestion in the

cited references concerning the method of the present invention, the Examiner has presented no more than an improper hindsight reconstruction of the present invention.

Claims 10, 15, 19, 22, 24, 26, 29, 32, 35, 44, 49, 53, and 56 recite similar language to the language of claim 1. Accordingly, the rejection is unsupported by the art and should be withdrawn.

The remaining claims are dependent claims that incorporate all of the limitations of at least one claim discussed above, and that further recite additional features and limitations. Accordingly, at least the arguments presented above apply to the dependent claims as well.

For example, with regard to claim 4, the Examiner correctly acknowledges that Nemzow "does not explicitly disclose receiving input overriding the selected exchange rate, the input comprising a second exchange rate." (2/27/06 Office Action at 5.) The Examiner states that the suggested modification would have been within the ordinary skill in the art, as the "open structure of the invention is meant to encompass as many scenarios as possible." MPEP § 2143.01 states "A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993.)" Because the reference actually teaches away from the suggested modification in favor of value optimization, there is no teaching to modify the reference. The Examiner is improperly using hindsight to reconstruct the present invention.

Similarly, with regard to claim 22, the Examiner states that it would have been obvious to one skilled in the art to "use the most recent historical exchange rate if the exact

date is not available because this is the most accurate measurement you would have."

(2/27/06 Office Action at 13.) However, once again, the Examiner has provided no teaching in the cited reference to support this modification. Indeed, as made clear in paragraphs 55 through 60, Nemzow teaches away from this modification, as it uses "optimization techniques...to maximize objective currency valuation and/or minimize conversion and transaction costs" when there is missing or out-of-date data. Thus, Nemzow does not seek an accurate valuation of a transaction based on preceding conversion values where there is missing data; it seeks to optimize (i.e. maximize) the value of the transaction.

Based on the above remarks, consideration of this application and the early allowance of all claims herein are requested.

Should the Examiner wish to discuss the above remarks, or if the Examiner believes that for any reason direct contact with Applicants' representative would help to advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,
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